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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,106	07/12/2000	Albhy Galuten	9386/1F699-US1	1564

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Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER	
GART, MATTHEW S	
ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,106

Applicant(s)

GALUTEN ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/12/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed on 11-14-00 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of AU A-36840/97 couldn't be located in the file.

Drawings

This application has been filed with informal drawings, which are acceptable for examination purposes only. Figures 1 through 3 contain improper lines and text, which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneck U.S. Patent Number 6,314,409.

Referring to claim 1. Schneck discloses a method for distributing electronic media content over a network from a central location (Fig. 1), comprising the steps of:

- Validating an offer for the distribution of the media content (column 9, line 59 to column 10, line 5);
 - Providing the validated offer for the distribution of the media content to a consumer (column 9, line 59 to column 10, line 5);
 - Receiving at the central location a request from the consumer to exercise the offer for the media content (column 9, line 59 to column 10, line 5);
 - Providing the media content to the consumer (System **100** includes two main components: a data distributor **102** and a user **104**. The data distributor **102** takes data 106 and produces packaged data **108** which are provided to the user 104 via communication channel **105**);
 - Receiving at the central location payment information from the consumer indicating at least the amount of compensation for the media content provided (Fig. 1, PAYMENT **110**); and
-

- Referencing one or more electronic financial terms to determine the allocation of the compensation among parties having a financial interest in the media content and allocating the compensation according to the one or more electronic financial terms (The data **106** are typically intellectual property subject to control. In some cases, distributor **102** may receive some form of payment **110** from the user **104** for accessing the data. This payment, or some part thereof, may then be provided directly to the actual owner (not shown) of the data **106**. Further, the payment or part thereof may be made before, during or after use of the data.).
Referring to claim 2. Schneck further disclose a method wherein the validating step further comprises the steps of:

- Referencing one or more electronic distribution terms (Claim 7);
- Comparing the offer against the one or more electronic distribution terms (Claim 7); and
- Validating the offer when the offer is consistent with the one or more electronic distribution terms (Claim 7).

Referring to claim 3. Schneck further discloses a method wherein the offer is provided by at least one of a retailer and a distributor, and the offer is provided to the central location (Fig. 1).

Referring to claims 4-5. Schneck further discloses a method wherein the referencing step further comprises allocating to the retailer / distributor a predetermined portion of the compensation according to the one or more electronic financial terms (The data **106** are typically intellectual property subject to control. In some cases,

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distributor **102** may receive some form of payment **110** from the user **104** for accessing the data. This payment, or some part thereof, may then be provided directly to the actual owner (not shown) of the data **106**. Further, the payment or part thereof may be made before, during or after use of the data.).

Referring to claims 6-7. Schneck further discloses a method wherein the one or more electronic financial terms comprise contractual terms of agreement between a distributor and a retailer with respect to the electronic media content (The data **106** are typically intellectual property subject to control. In some cases, distributor **102** may receive some form of payment **110** from the user **104** for accessing the data. This payment, or some part thereof, may then be provided directly to the actual owner (not shown) of the data **106**. Further, the payment or part thereof may be made before, during or after use of the data.).

Referring to claims 8-9. Schneck further discloses a method wherein the one or more electronic financial terms comprise contractual terms of agreement between a distributor and a group of retailers with respect to the electronic media content (column 3, lines 1-9).

Referring to claims 10-11. Schneck further discloses a method wherein the one or more electronic distribution terms comprise contractual terms of agreement between a distributor and a retailer (column 3, lines 1-9).

Referring to claims 12-13. Schneck further discloses a method wherein the one or more electronic distribution terms comprise contractual terms of agreement between a distributor and a group of retailers (column 3, lines 1-9).

Referring to claims 14-15. Schneck further discloses a method wherein the one or more electronic distribution terms comprise rules from a distributor for distribution of one or more of a group of electronic media contents (Abstract).

Referring to claim 17. Schneck discloses a method for validating an offer for the distribution of electronic media content by a distributor and retailer over a network from a central location (Fig. 1), comprising the steps of:

- Receiving at the central location one or more electronic distribution contracts from the distributor, wherein the one or more electronic distribution contracts govern the distribution of the media content (In some embodiments the rules are provided with the data, whereas in others the rules are provided separately. The rules can specify various access rights and controls, including rights of further distribution of the data.);
 - Receiving at the central location a candidate offer from the retailer (column 9, line 59 to column 10, line 5);
 - Checking the candidate offer against the one or more electronic distribution contracts from the distributor, wherein the checking step further comprises the step of referencing the one or more electronic distribution contracts in a predetermined order indicating the hierarchical relationship between the one or more electronic contracts (Fig. 12); and
 - Sending an indication of validation to the retailer when the candidate offer is determined to be consistent with the one or more electronic contracts (Fig. 12).
-

Referring to claim 18. Schneck further disclose a method wherein the validating step further comprises the steps of:

- Receiving at the central location one or more business rules from the distributor that apply to the distribution of the media content (Claim 7);
- Checking the candidate offer against the one or more business rules from the distributor (Claim 7); and
- Sending an indication of validation to the retailer when the candidate offer is determined to be consistent with the one or more business rules (Fig. 11 and Fig. 12).

Referring to claim 19. Schneck discloses a method for settling a transaction in the course of the distribution of electronic media content from a distributor to a consumer over a network from a central location (Fig. 1), comprising the steps of:

- Receiving at the central location one or more electronic distribution contracts from the distributor, wherein the one or more electronic distribution contracts govern the distribution of the media content (In some embodiments the rules are provided with the data, whereas in others the rules are provided separately. The rules can specify various access rights and controls, including rights of further distribution of the data.);
 - Distributing the electronic media content from the central location to the consumer (Fig. 1);
 - Receiving payment information from the consumer indicating at least the receipt of the electronic media content (Fig. 1); and
-

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- Referencing the one or more electronic financial contracts to determine the portion of compensation to be allocated to the distributor and allocating such portion of the compensation (The data **106** are typically intellectual property subject to control. In some cases, distributor **102** may receive some form of payment **110** from the user **104** for accessing the data. This payment, or some part thereof, may then be provided directly to the actual owner (not shown) of the data **106**. Further, the payment or part thereof may be made before, during or after use of the data.).

Referring to claim 20. Schneck further discloses a method wherein the electronic media content is distributed from the distributor to a consumer via a retailer (Fig. 1), the method further comprising the step of referencing the one or more electronic financial contracts to determine the portion of compensation to be allocated to the retailer and allocating such portion of the compensation (The data **106** are typically intellectual property subject to control. In some cases, distributor **102** may receive some form of payment **110** from the user **104** for accessing the data. This payment, or some part thereof, may then be provided directly to the actual owner (not shown) of the data **106**. Further, the payment or part thereof may be made before, during or after use of the data.).

Referring to claim 21. Claim 21 is rejected under the same rationale as set forth above in claim 1.

Referring to claims 22. Claim 22 is rejected under the same rationale as set forth above in claim 1.

Referring to claims 23. Claim 23 is rejected under the same rationale as set forth above in claim 17.

Referring to claims 24. Claim 24 is rejected under the same rationale as set forth above in claim 19.

Referring to claims 25. Claim 25 is rejected under the same rationale as set forth above in claim 1.

Referring to claims 26. Claim 26 is rejected under the same rationale as set forth above in claim 17.

Referring to claims 27. Claim 27 is rejected under the same rationale as set forth above in claim 19.

Conclusion

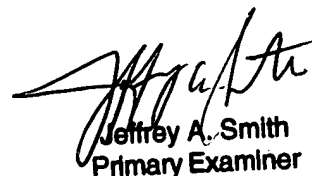
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Horstman, U.S. Patent No. 6,009,401, December 28, 1999; discloses a relicensing of electronically purchased software.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Jeffrey A. Smith
Primary Examiner

MSG

February 26, 2003
